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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,555	10/23/2003	John W. Stockstill	MCOG-0003-1	6414

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EXAMINER

MANAHAN, TODD E

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/690,555	Applicant(s) STOCKSTILL, JOHN W.	
	Examiner Todd E. Manahan	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/29/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-86 are rejected on the ground of nonstatutory double patenting over claims 1-53 of U. S. Patent No. 6,682,344 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

See MPEP § 804.

Applicant is advised that should claims 1-25 be found allowable, claims 51, 59-61, and 66-86 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the

Art Unit: 3732

same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17, 18, 41, 42, 78 and 79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 17, 41, and 78, “the x plane” lacks a prior antecedent.

In claims 18, 42, and 79, “the y plane” lacks a prior antecedent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7, 8, 12-14, 16-18, 26-54, 57-59, 68, 69, 73-75, and 77-79 are rejected under 35 U.S.C. 102(b) as being anticipated by Pearlman (United States Patent No. 4,134,208).

Pearlman discloses an orthodontic bracket placement device comprising a horizontal bracket engaging means, a vertical shaft 81 extending from the bracket engaging means, and indicia 82 on the shaft. The horizontal bracket engaging means forms a junction with the vertical

Art Unit: 3732

shaft that is off center of the bracket engaging means (see figure 8). The device further includes a stop 83 disposed on the vertical shaft. The device can be made of plastic or metal (see col. 3, lines 1-5; col. 4, lines 30-32). The indicia are in millimeters and half millimeters markings (col. 3 lines 10-14). Regarding claims 28-34, 38, and 43-50, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). Regarding claim 53, Pearlman includes a bracket 12. Regarding claim 51, Pearlman includes adhesive (col. 4, lines 35-37).

Claims 1, 2, 7, 8, 12-14, 17, 18, 26-54, 57-66, 68, 69, 73-75, 78, and 79 are rejected under 35 U.S.C. 102(b) as being anticipated by Damon (United States Patent No. 5,439,378).

Damon discloses an orthodontic bracket placement device comprising a horizontal bracket engaging means 80, a vertical shaft 85 extending from the bracket engaging means, and indicia 90 etched on the shaft. The horizontal bracket engaging means forms a junction with the vertical shaft that is off center of the bracket engaging means (see figure 20). Regarding method claims 26-50, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3732

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6, 11, 15, 21-25, 55, 56, 60-67, 72, 76, and 82-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearlman.

Regarding claims 3 and 4, it would have been obvious to one skilled in the art to make the indicia at least two different colors in order to readily differentiate between the different distances. Such scales are well known on measuring devices. Regarding claim 5, it would have been obvious to one skilled in the art to make the indicia etched in order to make such indicia more permanent. Etched indicia is old and well known in measuring devices. Regarding claim 6, it would have been obvious to one skilled in the art to make the indicia glow-in-the-dark in order that it be more readily visible in low light situations. Regarding claim 11, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the device of stainless steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Regarding claim 15, it would have been obvious to one skilled in the art to make the indicia correspond to placements of 3.5 mm, 4.0 mm, 4.5 mm, and 5.0 mm, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Regarding claims 21-25, it would have been obvious to one skilled in the art to make the bracket engaging means 0.1 to 0.2 inches in height; 0.16 inches in height; 2-4 mm in width; 5-15 mm in length; or 10 mm in, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. Regarding claims 55 and 56 it would

Art Unit: 3732

have been obvious to combine the device of Pearlman in a kit with and archwire in order that everything the orthodontist needs be readily available in one place.

Claims 1-8, 11-25, 51, 52, 59-61, 66-69, 72-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diamond.

Diamond discloses an orthodontic bracket placement device comprising a horizontal bracket engaging means 142, and a vertical shaft 140 extending from the bracket engaging means. The horizontal bracket engaging means forms a junction with the vertical shaft that is off center of the bracket engaging means (see figure 6B). The vertical shaft includes notches such that the height from stop 130 can be adjusted. Diamond however does not specifically disclose there being indicia on the vertical shaft. It would have been obvious to one skilled in the art to provide the vertical shaft of the device of Diamond with indicia in order for the user to readily identify the distance the bracket engaging means is from the stop. The device includes a threaded opening located at the end of the device opposite the bracket engaging means (see col. 5, lines 49-52). Regarding claims 3 and 4, it would have been obvious to one skilled in the art to make the indicia at least two different colors in order to readily differentiate between the different distances. Such scales are well known on measuring devices. Regarding claim 5, it would have been obvious to one skilled in the art to make the indicia etched in order to make such indicia more permanent. Etched indicia is old and well known in measuring devices. Regarding claim 6, it would have been obvious to one skilled in the art to make the indicia glow-in-the-dark in order that it be more readily visible in low light situations. Regarding claim 11, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the device of stainless steel, since it has been held to be within the general skill of

Art Unit: 3732

a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Regarding claim 15, it would have been obvious to one skilled in the art to make the indicia correspond to placements of 3.5 mm, 4.0 mm, 4.5 mm, and 5.0 mm, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Regarding claims 21-25, it would have been obvious to one skilled in the art to make the bracket engaging means 0.1 to 0.2 inches in height; 0.16 inches in height; 2-4 mm in width; 5-15 mm in length; or 10 mm in, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Allowable Subject Matter

Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 70 and 71 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 9 and 10. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Art Unit: 3732

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 571 272- 4713. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Todd E. Manahan
Primary Examiner
Art Unit 3732

T.E. Manahan
23 June 2006

A handwritten signature in black ink, appearing to read 'T.E. Manahan', with a long horizontal flourish extending to the right.